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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,602	12/12/2001	Christopher L. Adrien	ERIE-75	5540
26875	7590	06/17/2004	EXAMINER	
WOOD, HERRON & EVANS, LLP			CROSS, LATOYA I	
2700 CAREW TOWER				
441 VINE STREET			ART UNIT	
CINCINNATI, OH 45202			PAPER NUMBER	
			1743	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 10/021,602	<b>Applicant(s)</b> ADRIEN ET AL.	
	<b>Examiner</b> LaToya I. Cross	<b>Art Unit</b> 1743	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.  
     4a) Of the above claim(s) 8-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 41 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/1/02; 7/30/03; 10/13/03</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. Claims 1-7, 41 and 42, drawn to a cover slip/slide apparatus and method for forming a reaction chamber therewith, shown in figure 1.
- II. Claims 8-25, 34-40, drawn to a cover slip/slide apparatus and method for forming a reaction chamber therewith, shown in figures 2-8.
- III. Claims 26, 27, 30, 32 and 33, drawn to a cover slip/slide apparatus and method for forming a reaction chamber therewith, shown in figure 3.
- IV. Claim 28, drawn to a cover slip, classified in class 422, shown in figures 10 and 11.
- V. Claim 29, drawn to a cover slip, classified in class 422, shown in figure 12.
- VI. Claim 31, drawn to a cover slip, classified in class 422, shown in figure 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Attorney Richard Eby on June 7, 2004 a provisional election was made without traverse to prosecute the invention of group I, claims 1-7, 41 and 42. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Observations***

- Claims 1 and 5 recite "a thickness providing..." and claims 6 and 7 recite "a thickness sufficient..." It is not readily apparent to the reader that Applicants intend to describe the thickness of the cover slip. It is suggested that Applicants amend the claims to recite "wherein the thickness of the cover slip is sufficient to provide ..." or similar language.  
slide (2), as best shown in figure 1b.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 41 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,489,171 to Aghassi et al.

Aghassi et al teach a slide device for holding a tissue sample. The slide comprises a specimen substrate (9) and a cover plate (cover slip, 8). A spacer (10a) is placed between slide (9) and cover plate (8), wherein the spacer is sandwiched in between the slide and the cover plate, as best shown in figure 1b. Aghassi et al teach that the spacer (10a) extends along the length of the slide device and seals the outer edges of the slide device to keep the chemicals between the slide and the cover plate (col. 5, lines 51-62). Further, Aghassi et al teach when the chemicals are injected into the slide device, they fill the head space and interact with the

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tissue sample (6). The spacer may be disposed about the entire perimeter of the slide device to surround the head space (col. 6, lines 7-11).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Re 35,589 to Fisch in view of US patent 4,171,866 to Tolles.

Fisch discloses a device for examining a sample under magnification. The device comprises a slide substrate (20) for holding a sample specimen and a cover slip (3) for covering the sample. Fisch also discloses a thin spacer layer (23) sandwiched between the cover slip (3) and the slide (2). The space formed by the spacer layer (23) creates a circular sample chamber, in which the sample will remain during examining. See figure 1a and 1b. Fisch also disclose that the cover slip is made of glass and has a thickness of 0.1 – 0.5 mm (col. 3, lines 60-61), which would provide sufficient beam stiffness and allow the reaction of adhesion forces. In use,

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the user drops a sample into the sample chamber and applies the cover slip to the top of the slide. When the cover slip is applied to the slide, the cover slip is affixed to the thin spacer layer.

Fisch differs from the instantly claimed invention in that the spacer layer of Fisch is not taught as being "a pair of spacer segments" that extends along substantially a full length of a different one of the opposed edges.

Tolles is directed to a slide device for examining samples. Tolles describes a device comprising a slide substrate (11) for holding a sample specimen and a cover slip (13) for covering the specimen. Tolles further teaches the presence of at least two parallel spacers (12) that are raised and support the cover slip (13), creating a chamber (14) between the slide (11) and cover slip (13). In figure 1 the spacers are shown as parallel lands that extend along the full length of the cover slip.

It would have been obvious to one of ordinary skill in the art to use the parallel spaced spacers of Tolles in the device of Fisch to allow the sample to be inserted into the chamber of the slide while the cover slip is attached to the slide. Such would prevent any contamination resulting from inserting the sample and having to place the cover slip on the sample already present in the chamber. Also, because the parallel spacers of Tolles allow the specimen aliquot to spread out by capillary action, a lesser amount of sample will be needed to fill the chamber to an amount sufficient for examining.

#### ***Citation of Relevant Prior Art***

US Patent 4,447,140 to Campbell teaches a microscope slide having spacers (34) that run parallel to one another.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jill Warden  
Supervisory Patent Examiner  
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